



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,899	03/29/2001	Jim Paul Haughwout	06975-144001 / Member Ser	5374

26171 7590 08/12/2003

FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON, DC 20005-3500

EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,899

Applicant(s)

HAUGHWOUT, JIM PAUL

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's "Reply" filed on May 27, 2003 has been considered with the following effect.

Examiner acknowledges the remark to claim 83 and has overcome the Examiners' rejection of such claims under 35 USC 112, second paragraph.

Claims 1, 2, 4, 5, 7, 16, 36, 37, 39, 40, 42, 48, 52, 63, 64, 66, 67, 69, 75, and 79 have been amended. Claims 1-89 remain pending and an action on the merits of these claims follows.

Drawings

There were no amended drawings of Figs. 7A through 10 included with the "Reply".

Response to Arguments

Applicant's arguments with respect to claims 1-89 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks that "Owensby does not describe or suggest transferring a call of a caller to a human operator, and assisting the human operator to present an automatically selected first sales pitch to the caller required by the amended independent claims 1, 36, and 63". Furthermore, Applicant's remarks that "Owensby does not describe or suggest, and in fact teaches away from transferring a call or a caller to a human operator, and assisting the human operator to present an automatically selected first sales pitch to the caller".

Art Unit: 3625

The Examiner notes that the recitation of "human" operator is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "operator" already disclosed by Owensby. However, Owensby discloses transferring a call or caller to an operator and assisting the operator to present an automatically selected first sales pitch to the caller. In paragraphs 16 and 43, Owensby discloses the subscriber responds to the operator's query and the operator may fulfill the subscriber's request following a particular message. Such subscriber responding to the operator's query and the operator fulfilling the subscriber request following a particular message are considered the transferring of a caller to an operator and assisting the operator to present the first sales pitch to the caller.

Applicant's remarks that "Owensby and Kamel do not disclose transferring a call to a human operator and assisting the human operator to present an automatically selected first sales pitch to the caller as recited in the amended independent claims 1, 36, 63". Furthermore, Applicant's remarks that "due to the failure to teach or suggest the above-noted features of claims 1, 36, and 63, either alone or in combination, it is respectfully submitted that the proposed combination of Owensby and Kamel".

The Examiner directs Applicant's attention to the Examiner's response to Applicant's previous remarks regarding claims 1, 36, and 64 (discussed above). Therefore, the combination of Owensby and Kamel does teach or suggest the features of claims 1, 36, and 63.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made..

Claims 1-21, 25-34, 36-51, 55-61, 63-78, and 82-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby.

Owensby discloses a process and system for assisting presentation of a first sales pitch for a particular caller of a telephone call center, comprising: compiling a first database of pre-selected messages to be targeted to the subscriber and predetermining criteria for choosing the messages to be targeted to the subscriber (automatically selecting a first sales pitch appropriated for the caller based upon the information accessed about the caller); transmitting a wireless mobile communication comprising a call signal and Wireless Mobile Location data included with the call signal (receiving a call from a caller); utilizing the predetermined criteria of the first database to choose a message from the plurality of pre-selected messages of the first database that is targeted to the subscriber on the based on the wireless mobile location of the terminal (accessing information about the caller gathered prior to the call); transferring the call to an operator (the subscriber responding to the operator's query; paragraphs 16 and 43); and assisting the operator to present the first sales pitch to the caller (the

Art Unit: 3625

subscriber responding to the operator's query and the operator fulfilling the subscriber's request following a message). (See paragraphs 16 and 43). Furthermore, the system and method permit the subscriber to interactively respond to a message provided to the subscriber, or to an inquiry for additional information from the operator of the service or from the sponsor of the message. Preferably, the operator queries the subscriber at the conclusion of a message, at the conclusion of a group of messages or at the conclusion of the wireless mobile communication, to select one of several options and then monitors the subscriber's response to the query. For example, the subscriber could request the operator to insert another message (second sales pitch) into the wireless mobile communication, to forward an audio, video or electronic data copy of the previously provided message to an electronic message input, storage and retrieval database (e.g., voice mail, e-mail, facsimile, etc.), or to establish a direct telecommunications or other data link with a representative of the sponsor of the message. The subscriber may respond to the operator's query and the operator may fulfill the subscriber's request immediately following a particular message, immediately following a group of messages or following the conclusion of the wireless mobile communication (e.g., in the form of a "call-back" from a representative). (See paragraph 16) The messages are further targeted to the subscriber on the basis of: predetermined Subscriber Profile Data pertaining to the subscriber previously provided to the subscriber which is stored in an electronic database; Historical Response Data relating to the responses made to the targeted messages which is stored in an electronic database (historical information based on responses made by the caller in

Art Unit: 3625

response to past sales pitch offers); and Historical Response Data relating to the historical movement patterns of the subscriber which is stored in an electronic database (historical information based on past misbehavior of the caller) (see at least paragraph 2). The Subscriber Profile Data includes demographic and personal preference data (e.g. name, address, and home telephone number) which pertain to the subscriber that is collected from the subscriber at the time the subscriber registers with the operator of the communication services, and is stored in an electronic data, input, storage, and retrieval device and updated at regular intervals (wherein information accessed about the caller comprises information regarding current enrollment by the caller in products or services offered by a commercial partner). The message can also be further targeted to the subscriber based on the geographical location of the subscriber (accessing information about the caller includes accessing a geographic residence of the caller) (see paragraph 11). Furthermore, the system discloses Ad insert Records which computes the Subscriber Billing Subsidy to be credited to the subscriber account, wherein the Ad Insert Records is forwarded to the Operator Billing System to apply the Subscriber Billing Subsidy to the appropriate subscriber (satisfactory credit status) (see paragraph 52). The system also includes an Ad Target Data, which is a database management program that inputs and stores messages the meet a criteria for choosing (relationship between products and services of commercial partners). Moreover, the system includes a Call Routine Generator which embodies an algorithm setting out the rules for assigning targeted advertisements to call in view of the Ad Selection Code and the Ad Target Data. The

Art Unit: 3625

algorithm of the Call Routine Generator is a multiple step process that begins with a large pool of advertisements and narrows the pool until only advertisement with protocols that are satisfied by the Ad Selection Code remain (automatically determining a pool of available sales pitches). The Call Routine Generator may generate a secondary pool consisting of rejected advertisements. (See at least paragraph 64-71).

However, Owensby does not explicitly disclose that the operator is specifically, human. Although the reference is silent to the particular operator, it would have been obvious to one of ordinary skill in the art to have provided the operator already disclosed by Owensby to have been human, such particular operator would have been recognized by the skilled artisan as being one of numerous operators. Moreover, applicant has not persuasively demonstrated that the particular operator is critical or is anything more than one of the numerous operators that the skilled artisan would have found suitable for the purpose taught by Owensby. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process and system of Owensby, to include a human as an operator, such as the operator taught in Owensby, in order to provide assistance to a caller.

Claims 22-24, 35, 52-54, 62, 79-81, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby as applied to claims 1, 36 and 63 above, and further in view of U.S. Paten No. 5,937,037 to Kamel et al.

Owensby discloses substantially the claimed invention, however, it does not disclose the commercial partner providing a second sales pitch to the caller and a relationship between products and services of one commercial partner to sales pitches

Art Unit: 3625

corresponding to products and services of another commercial partner. Kamel, on the other hand, teaches a system and method which are configured to support a wide range of functionality to meet the message delivery (sales pitch) specifications provided by third party sponsors (commercial partner). These functionalities include message targeting, conditional message delivery, message grouping and sequencing, message frequency, interactivity, information capture, and updates (second sale pitch). (See at least col. 11, line 34 – col. 13, line 53). Furthermore, Kamel teaches a message bank which contain promotional messages, such as advertisements, to be delivered to subscribed calling parties and/or called parties. The promotional messages are provided by third party sponsors (commercial partners). The message bank has a plurality of electronic queues for storing data indicative of promotional messages and receives, stores and maintains a copy of all messages and their associated targeting parameters for all active campaigns. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Owensby, to include the second sales pitch of the commercial partner, as taught by Kamel, in order to provide a targeted message based on a caller's response.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3625

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot
August 11, 2003


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600